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| 09/803,845      | 03/12/2001  | Sam J. DiRaimondo    | CM01891G            | 1286             |

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EXAMINER

PHAN, RAYMOND NGAN

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2111

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Applicati n N .

09/803,845

Applicant(s)

DIRAIMONDO ET AL.

Examin r

Raymond Phan

Art Unit

2111

-- The MAILING DATE of this communicati n appears n the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-20 is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 9, 21 and 22 is/are rejected.
- 7) ☒ Claim(s) 5-7, 10 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **Part III DETAILED ACTION**

#### ***Notice to Applicant(s)***

1. This action is responsive to the following communications: amendment filed on January 15, 2004
2. This application has been examined. Claims 1-22 are pending.
3. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2111.

#### ***Specification***

4. The title of the invention is accepted.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 8-9, and 21-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman et al. (US No. 6,068,183) in view of Matyas et al. (US No. 5,007,089).

In regard to claim 1, Freeman et al. disclose a method of regulating usage in a smart card system comprising at a card acceptance location (see col. 4, lines 17-

60); detecting the presence of the card (see col. 4, lines 17-60); determining an ID code from the smart card (see col. 4, lines 17-60). But Freeman et al. do not specifically disclose the checking the ID code against a list stored locally at the card acceptance location, wherein the list is received from a second device; and if the ID code of the smart card is listed on the list, performing an action on the smart card. However Matyas et al. disclose the checking the ID code against a list stored locally at the card acceptance location, wherein the list is received from a second device (see col. 4, lines 5-50); and if the ID code of the smart card is listed on the list, performing an action on the smart card (see col. 4, lines 5-50). Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to have combined the teachings of Matyas et al. within the system of Freeman et al. because it would improve security of database system.

In regard to claim 2, Freeman et al. disclose the step of modifying the parameter of the card (see col. 3, line 46 through col. 4, line 60). But Freeman et al. do not disclose wherein the action is selected from a group of consisting of disabling the smart card, enabling the smart card. However Matyas et al. disclose the action is selected from a group of consisting of disabling the smart card, enabling the smart card (see col. 4, line 50 through col. 5, line 20). Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to have combined the teachings of Matyas et al. within the system of Freeman et al. because it would improve security of database system.

In regard to claims 3, 21, Matyas et al. disclose wherein the smart card has a status data/bit, wherein the action performed is disabling the smart card that comprises at least one of the step (see col. 4, line 50 through col. 5, line 20): changing the status data/bit in the smart card to indicate disable (see col. 4, line 50

through col. 5, line 20); and blocking an area of memory located within the smart card (see col. 4, line 50 through col. 5, line 20). Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to have combined the teachings of Matyas et al. within the system of Freeman et al. because it would improve security of database system.

In regard to claims 4, 22, Matyas et al. disclose wherein the smart card has a status data/bit, wherein the action performed is enabling the smart card that comprises at least one of the step (see col. 4, line 50 through col. 5, line 20): changing the status data/bit in the smart card to indicate enable (see col. 4, line 50 through col. 5, line 20); and unblocking an area of memory located within the smart card (see col. 4, line 50 through col. 5, line 20). Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to have combined the teachings of Matyas et al. within the system of Freeman et al. because it would improve security of database system.

In regard to claim 8, Freeman et al. disclose wherein the action performed is modifying parameter to the smart card which indicates discounts, rebate, purchase (see col. 3, line 46 through col. 4, line 16).

In regard to claim 9, Freeman et al. disclose wherein the parameter is based on at least loyalty program, type of concession (see col. 3, line 46 through col. 4, line 16).

***Allowable Subject Matter***

7. Claims 12-20 are allowable over the prior of records.
9. Claims 5-7, 10-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Amendment***

10. Applicant's arguments, see pages 8-10, filed on January 15, 2004, with respect to the rejection(s) of claim(s) 1-4, 8-9 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Freeman et al. and Matyas et al.

***Conclusion***

11. Claims 1-4, 8-10, 21-22 are rejected. Claims 5-7 and 10-11 are objected. Claims 12-20 are allowed.
12. The prior arts made of record and not relied upon are considered pertinent to applicant's disclosure.

**Nichtberger et al. (US No. 4,882,675)** disclose a paperless system for distributing redeeming and clearing merchandise coupons.

**Taylor (US No. 5,578,808)** discloses a data card that can be used for transactions involving separate card issuers.

**Masada (US No. 5,012,074)** discloses an apparatus for securing a IC-card issuing station.

**Claus (US No. 5,461,217)** discloses secure money transfer techniques using smart cards.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Raymond Phan, whose telephone number is (703) 306-2756. The examiner can normally be reached on Monday-Friday from 6:30AM- 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Primary, Paul Myers can be reached on (703) 305-9656 or via e-mail addressed to paul.myers@uspto.gov. The fax phone number for this Group is (703) 746-7239.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [raymond.phan@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.



**Raymond Phan**  
3/22/04